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In re Application of :
ROSS, Ralph, et al. :
U.S. Application No.: 09/889,834 : DECISION ON PETITION
PCT No.: PCT/GB00/00176 : UNDER 37 CFR 1.47(a)
International Filing Date: 24 January 2000 :
Priority Date: 23 January 1999 :
Attorney's Docket No.: CAF-28502/03 :
For: CARGO HANDLING APPARATUS :

This decision is issued in response to the "Petition For Filing Application By Other Than All The Inventors Under 37 CFR 1.47(a)" filed on 22 February 2002. In a supplemental submission filed 25 February 2002, applicants included the required petition fee.

BACKGROUND

On 24 January 2000, applicants filed international application PCT/GB00/00176 which claimed a priority date of 23 January 1999 and which designated the United States. On 27 July 2000, a copy of the international application was transmitted to the United States Patent And Trade Office ("USPTO") by the International Bureau ("IB").

On 18 August 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 23 July 2001.

On 23 July 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 30 August 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date was required. The Notification also informed applicants that the failure to submit the declaration within two months of the date of the Notification would result in abandonment of the application.

On 28 November 2001, applicants filed a response to the Notification Of Missing Requirements (including the necessary extension fee) which was accompanied by the required

surcharge payment and a declaration executed by Ralph Ross, one of the two named inventors; the declaration was not executed by the second inventor Michael Wayne Crabtree. The submission stated that a petition under 37 CFR 1.47 would be forthcoming.

Despite the fact that applicants had failed to submit a fully executed declaration, on 12 December 2001, the DO/EO/US mailed a Notification Of Acceptance stating that 28 November 2001 was the receipt date for the requirements of 35 U.S.C. 371.

On 22 February 2002, applicants filed the petition considered herein, seeking acceptance of the application without the signature of Mr. Crabtree, who applicants claim has refused to execute the application. In order to make the petition a timely response to the Notification Of Missing Requirements mailed 30 August 2001, applicants have been charged the fee for a four month extension of time. Based on this extension, the petition is considered a timely response to the Notification Of Missing Requirements.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As discussed below, applicants here have satisfied all these requirements.

Regarding the petition fee, applicants have submitted a payment in the amount of \$130. Item (1) is therefore satisfied.

The petition specifically sets forth the address of the nonsigning inventor, Michael Wayne Crabtree. Accordingly, item (2) is satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Procedure (“MPEP”) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants here have filed a declaration executed by co-inventor Ralph Ross and containing an unsigned signature block for the nonsigning inventor. Pursuant to the MPEP, this declaration has been treated as having been signed by co-inventor Ross on his own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), applicants' assert that Mr. Crabtree refuses to execute the application. Here, the evidence submitted by applicants to demonstrate Mr. Crabtree's refusal to execute the application is contained in the petition and its attachments, most specifically in the 18 October 2001 letter from Mr. Wayne S. Breyer, counsel for the nonsigning inventor. In that letter, Mr. Breyer expressly states that Mr. Crabtree's signature "will not be forthcoming." However, applicants have not provided evidence that Mr. Crabtree has been provided with a complete copy of the present application (including description, claims, and drawings), a prerequisite to asserting a refusal to sign (the Breyer letter implies familiarity with the application, but it is not conclusive on this point). In addition, a statement from Mr. Shanks, the attorney with firsthand knowledge of the communications with the nonsigning inventor and to whom the refusal was made, is also required (see MPEP 409.03(d)). On the current record, item (4) is not satisfied.

Applicants' have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a).

Finally, applicants have included with the petition a request for a corrected filing receipt because the filing receipt mailed on 12 December 2001 fails to list Mr. Crabtree as an inventor. Both the filing receipt and the Notification Of Acceptance were issued prematurely in that applicants have not yet satisfied the requirements for entry into the national stage. Accordingly, the filing receipt and Notification Of Acceptance will be vacated. Should applicants successfully complete entry into the national stage, a new Notification Of Acceptance and filing receipt will be issued, and such filing receipt will be made to include both inventors' names.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The Notification Of Acceptance mailed 12 December 2001 and the filing receipt mailed 12 December 2001 are hereby **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include adequate evidence that the nonsigning inventor has been presented with a copy of the complete application and the firsthand statement from Mr. Shanks, as discussed above and in the form required by MPEP § 409.03(d). No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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